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EXAMINER
BURGE, LONDRA C

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/826,935	LLOYD-JONES ET AL.
	Examiner	**Art Unit**	
	Londra C Burge	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 November 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6,8,11-29,31 and 34-54* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8,11-29,31 and 34-54* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date *6/8/01*.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: Amendment filed 11/4/2004.

2.   Claims 1-6, 8, 11-29, 31 and 34-54 are pending. Claims 1 and 24 are independent claims,

claims 7, 9, 10, 30, 32 and 33 have been cancelled and claims 45-54 are newly added claims.

3.   The rejections of claims 7, 9, 10, 30, 32 and 33 have been withdrawn, because of

cancellation by the applicant.

4.   This action has been made Final.

Claim Rejections - 35 USC § 103

5.   **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all**

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   **Claims 1-6, 8, 11-18, 20-29, 31, 34-41 and 43-54 remain rejected under 35 U.S.C.**

103(a) as being unpatentable over Eintracht et al. (herein after Eintracht) U.S. Patent No.

6,687,878 B1 filed 3/15/1999 in view of Schelling et al. (herein after Schelling) U.S.

5,706,097 filed 1/6/1998 provided by the applicant.

In regard to independent claim 1, Eintracht discloses *displaying the image and a*

plurality of icons, each icon being associated with one or more predetermined items of

metadata; selecting at least one of the icons depending on at least one...of the image (Eintracht

Col 15 Lines 10-23 and Figs 1B and 1C i.e. Note Icons that are selected, which contain

information about an image)(Eintracht Col 14 Lines 14-22 i.e. selecting an annotation); *linking*

the predetermined items of metadata associated with the selected icon with a description of the

location of the subject within the image; and storing the linked metadata and the description as

an annotation of the image. (Eintracht Col 19 Lines 42-67 i.e. storing notes associated with a

document or image and Col 13 Lines 25-55 i.e. indicated that a URL is selected which means the

items are linked at a predetermined location).

Eintracht does not specifically mention where there is a subject rendered at a location of

the annotation is displayed with the icon is placed on the images. However, Schelling mentions a

subject matter descriptor, which indicates the type of subject matter in the data file (Schelling

Col 2 Lines 1-15). It would have been obvious to one of ordinary skill in the art to apply

Schelling to Eintracht, providing Eintracht the benefit of detecting the subject of an image

without having to individually go into each image to find out the subject, which would save time

for the user.

In regard to dependent claim 2, Eintracht *dragging the selected icon to the image;*

dropping the dragged icon on the... image (Eintracht Col 15 Lines 24-27 i.e. grabbing a note

icon and dragging it to a new location on the image).

Eintracht does not specifically mention where there is a subject of the annotation is

displayed with the icon is placed on the images. However, Schelling mentions a subject matter

descriptor, which indicates the type of subject matter in the data file (Schelling Col 2 Lines 1-

15). It would have been obvious to one of ordinary skill in the art to apply Schelling to Eintracht,

providing Eintracht the benefit of detecting the subject of an image without having to

individually go into each image to find out the subject, which would save time for the user.

In regard to dependent claim 3, Eintracht does not specifically disclose *wherein the bounded region is formed based on an analysis of pixels of the image* (Eintracht Col 7 Line 10-15 i.e. based on note color label and Col 18 Lines 15-30 i.e. dimensions based on width and height in pixels per millimeter).

In regard to dependent claim 4, Eintracht discloses *wherein the analysis includes an analysis of the color information of the pixels of the image* (Eintracht Col 7 Line 10-15 i.e. based on note color label and Col 18 Lines 15-30 i.e. dimensions based on width and height in pixels per millimeter Col 6 Lines 65-67 and Col 7 Lines 1-17).

In regard to dependent claim 5, Eintracht discloses *wherein the bounded region is of a predetermined size.* (Eintracht Col 18 Lines 15-30 i.e. dimensions based on width and height in pixels per millimeter Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 6, Eintracht discloses *further comprising the step of forming a bounded region within the image about the location at which the subject is rendered in said image, the bounded region being configured to substantially surround the subject.* (Eintracht Col 15 Lines 10-14 i.e. region box is created where the cursor is placed to write an annotation and Col 15 Lines 10-17 i.e. region box is created where the cursor is placed to write an annotation and subject at a certain location Col 6 Lines 65-67 and Col 7 Lines 1-17).

In regard to dependent claim 8, Eintracht discloses *a bounded region under the dragged icon is emphasized.* (Eintracht Col 15 Lines 24-35 i.e. Notes can be created by selecting an annotation tool on the screen and placing the cursor in the area of the image where it is desired to place a note. A box is created and the user can enter text. Once entered, the text appears in the form of a `stick` note that appears on top of the image. The Note Anchor is

created at the location the user placed the note. Notes can be viewed by double clicking, for

example, on a note icon. Note icons are displayed on the screen when the viewing option is set

to display both notes and the image. A note can be closed after viewing by clicking on the box

in the upper left-hand corner of the title bar 32 (FIG. 2). Note that alternatively, graphics can be

entered into a note rather than test. In this case, a graphics tool or marker is used to place

graphics in the note)

In regard to dependent claim 11, Eintracht discloses *further comprising the step of*

extracting a part of the image based on the bounding region. (Eintracht Col 6 Lines 65-67 and

Col 7 Lines 1-17)

In regard to dependent claim 12, Eintracht discloses *further comprising the step of*

displaying the extracted part of the image. (Eintracht Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 13, Eintracht discloses *wherein a size of the bounded*

region is determined automatically. (Eintracht Col 15 Lines 10-17 i.e. region box is created

where the cursor is placed to write an annotation and subject at a certain location and Col 10

Lines 64-67 and Col 11 Lines 1-5).

In regard to dependent claim 14, Eintracht discloses *wherein a size of the bounded*

region is changeable by a user. (Eintracht Col 15 Lines 10-17 i.e. region box is created where

the cursor is placed to write an annotation and subject at a certain location and Col 10 Lines 64-

67 and Col 11 Lines 1-5).

In regard to dependent claim 15, Eintracht discloses *wherein the metadata stored as the*

annotation of the subject is displayed upon selecting the subject in the image. (Eintracht Col 7

Lines 13-17 i.e. the display may include Note Event description, Note Owner ID, user name,

path, originator IP address, time and Note Contents. When a note is selected on the Note List,

its counterpart icon in the document window frame is highlighted)

In regard to dependent claim 16, Eintracht discloses *providing a list of metadata; and*

associating the list of metadata and the plurality of icons. (Eintracht Col 7 Lines 4-17 i.e. the

image window 18 displays the image with the plurality of annotations on top of the image. The

Note List window displays a list of all the annotations associated with the image shown in

window. The user can optionally sort the Note List by Note Owner ID, Note Time Stamp, Note

color label and Note Contents. The display may include Note Event description, Note Owner

ID, user name, path, originator IP address, time and Note Contents. When a note is selected on

the Note List, its counterpart icon in the document window frame is highlighted)

In regard to dependent claim 17, Eintracht discloses *wherein the list of metadata is*

provided from a database. (Eintracht Col 7 Lines 44-46 i.e. coupled to a notes database).

In regard to dependent claim 18, Eintracht discloses *wherein said storing step included*

storing the metadata as the annotation of the subject of the image by using a tag indicating an

association with the image. (Eintracht Col 3 Lines 13-36 i.e. the document file for storing one

or more documents, a notes database located on the server, the notes database for storing one or

more notes, each note or tag associated with a particular document or subject, one or more notes

clients coupled to a network, each notes client operative to locally display a representation of a

document remotely stored on the server in the document file, the notes client adapted to permit

a user to annotate the document with one or more notes, the notes client operative to

simultaneously display the one or more notes associated with the document over the displayed

document such that the document is viewable along with the one or more notes)

In regard to dependent claim 20, Eintracht discloses *further comprising the step of e-mailing at least the image to at least one e-mail address based on the metadata associated with the image.* (Eintracht Col 22 Lines 33-37 i.e. emails to client or user)

In regard to dependent claim 21, Eintracht discloses *further comprising the step of replacing the default icon by the icon generated based on the subject of the image.* (Eintracht Col 3 Lines 33-37 i.e. updating the notes server with any notes events processed by the notes clients and for updating the notes client with the results of synchronization updates previously performed by other notes clients since the last synchronization event and Col 15 Lines 15-17 i.e. icons)

In regard to dependent claim 22, Eintracht discloses *a computer program and code for a computer, comprising software code portions for performing the steps* (Eintracht Col 28 Lines 1-27)

In regard to dependent claim 23, Eintracht discloses *a computer readable medium storing a computer program, wherein said computer program comprises software code portions for performing the steps* (Eintracht Col 28 Lines 1-27)

In regard to independent claim 24, claim 24 in addition to the following reflects similar subject matter claimed in claim 1 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 25, claim 25 in addition to the following reflects similar subject matter claimed in claim 2 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 26, claim 26 in addition to the following reflects similar subject matter claimed in claim 3 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 27, claim 27 in addition to the following reflects similar subject matter claimed in claim 4 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 28, claim 28 in addition to the following reflects similar subject matter claimed in claim 5 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 29, claim 29 in addition to the following reflects similar subject matter claimed in claim 6 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 30, claim 30 in addition to the following reflects similar subject matter claimed in claim 7 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 31, claim 31 in addition to the following reflects similar subject matter claimed in claim 8 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 32, claim 32 in addition to the following reflects similar subject matter claimed in claim 9 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 33, claim 33 in addition to the following reflects similar subject matter claimed in claim 10 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 34, claim 34 in addition to the following reflects similar subject matter claimed in claim 11 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 35, claim 35 in addition to the following reflects similar subject matter claimed in claim 12 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 36, claim 36 in addition to the following reflects similar subject matter claimed in claim 13 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 37, claim 37 in addition to the following reflects similar subject matter claimed in claim 14 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 38, claim 38 in addition to the following reflects similar subject matter claimed in claim 15 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 39, claim 39 in addition to the following reflects similar subject matter claimed in claim 16 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 40, claim 40 in addition to the following reflects similar subject matter claimed in claim 17 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 41, claim 41 in addition to the following reflects similar subject matter claimed in claim 18 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 43, claim 43 in addition to the following reflects similar subject matter claimed in claim 20 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 44, claim 44 in addition to the following reflects similar subject matter claimed in claim 21 and is rejected along the same rationale. A Display, selection and storage means (Eintracht Col 20 Line 16-22).

In regard to dependent claim 45, Eintracht discloses *wherein the description includes a location of the bounded region within the image.* (Eintracht Col 15 Lines 10-14 i.e. region box is created where the cursor is placed to write an annotation and Col 15 Lines 10-17 i.e. region box is created where the cursor is placed to write an annotation and subject at a certain location Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 46, Eintracht discloses *wherein the description includes a size of the bounded region.* (Eintracht Col 18 Lines 15-30 i.e. dimensions based on width and height in pixels per millimeter Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 47, Eintracht discloses *wherein the bounded region is formed at a location at which the selected icon is dropped on the image.* (Eintracht Col 15 Lines 24-27 i.e. grabbing a note icon and dragging it to a new location on the image)

In regard to dependent claim 48, Eintracht discloses *wherein a size of the bounded region is determined based on the analysis.* (Eintracht Col 18 Lines 15-30 i.e. dimensions based on width and height in pixels per millimeter Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 49, Eintracht discloses *wherein only the linked metadata and the description are stored as an annotation of the subject of the image.* (Eintracht Col 7 Lines 13-17 i.e. the display may include Note Event description, Note Owner ID, user name, path, originator IP address, time and Note Contents. When a note is selected on the Note List, its counterpart icon in the document window frame is highlighted) (Eintracht Col 19 Lines 42-67 i.e. storing notes associated with a document or image and Col 13 Lines 25-55 i.e. indicated that a URL is selected which means the items are linked at a predetermined location)

In regard to dependent claim 50, Eintracht discloses *wherein the description of the bounded region includes a location of the bounded region within the image.* (Eintracht Col 15 Lines 24-27 i.e. grabbing a note icon and dragging it to a new location on the image) (Eintracht Col 15 Lines 10-14 i.e. region box is created where the cursor is placed to write an annotation and Col 15 Lines 10-17 i.e. region box is created where the cursor is placed to write an annotation and subject at a certain location Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 51, Eintracht discloses *wherein the description of the bounded region includes a size of the bounded region.* (Eintracht Col 18 Lines 15-30 i.e.

dimensions based on width and height in pixels per millimeter Col 6 Lines 65-67 and Col 7

Lines 1-17)

In regard to dependent claim 52, Eintracht discloses *wherein the bounded region is*

formed at a location at which the icon is dropped on the image. (Eintracht Col 15 Lines 24-27

i.e. grabbing a note icon and dragging it to a new location on the image)

In regard to dependent claim 53, Eintracht discloses *wherein a size of the bounded*

region is determined based on the analysis. (Eintracht Col 18 Lines 15-30 i.e. dimensions based

on width and height in pixels per millimeter Col 6 Lines 65-67 and Col 7 Lines 1-17)

In regard to dependent claim 54, Eintracht discloses *wherein only the linked metadata*

and the description are stored as an annotation of the subject of the image. (Eintracht Col 7

Lines 13-17 i.e. the display may include Note Event description, Note Owner ID, user name,

path, originator IP address, time and Note Contents. When a note is selected on the Note List,

its counterpart icon in the document window frame is highlighted) (Eintracht Col 19 Lines 42-

67 i.e. storing notes associated with a document or image and Col 13 Lines 25-55 i.e. indicated

that a URL is selected which means the items are linked at a predetermined location)

7.   **Claims 19 and 42 remain rejected under 35 U.S.C. 103(a) as being unpatentable**

over Eintracht et al. (herein after Eintracht) in view of Schelling et al. (herein after

Schelling) as applied to claims 1 and 24 and in further view of Martin et al. (herein after

Martin) U.S. Patent No. 6,272,484 B1 filed 5/27/1998.

In regard to dependent claim 19, Eintracht does not disclose *wherein the metadata*

associated with the subject of the image is stored in an XML file. However, Martin mentions a

format for storing documents being XML (Martin Col 6 Lines 30-33). It would have been

obvious to one of ordinary skill in the art to apply Martin to Eintracht, providing Eintracht the

benefit of storing the data in an XML format which would be option format when the user

accesses a document over the internet of which there are many formats for different web pages as

taught by Martin Col 6 Lines 29-37)

In regard to dependent claim 42, claim 42 in addition to the following reflects similar

subject matter claimed in claim 19 and is rejected along the same rationale. A Display, selection

and storage means (Eintracht Col 20 Line 16-22).

Response to Arguments

8.   **Applicant's arguments filed 11/4/2004 have been fully considered but they are not**

persuasive.

The applicant argues that displaying the image and a plurality of icons, each icon being

associated with one or more predetermined items of metadata; selecting at least one of the icons

depending on at least one subject rendered at a location within the image; linking the

predetermined items of metadata associated with the selected icon with a description of the

location of the subject within the image; and storing the linked metadata and the description as

an annotation of the image (Page 16 Para 3). However Eintracht Col 15 Lines 10-23 and Figs 1B

and 1C show Note Icons that are selected, which contain information about an image and

Eintracht Col 14 Lines 14-22 indicates selecting an annotation.

The applicant also argues forming a bounded region within the image about the location

at which the subject is rendered in the image, the bounded region being configured to

substantially surround the subject (Page 18 Para 4). However, Eintracht Col 15 Lines 10-14 mentions a region box is created where the cursor is placed to write an annotation and Col 15 Lines 10-17, Col 6 Lines 65-67 and Col 7 Lines 1-17 mentions the region box is created where the cursor is placed to write an annotation and subject at a certain location.

Conclusion

9.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Londra C Burge whose telephone number is (571) 272-4122. The examiner can normally be reached on 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCB
3/15/2005

CESAR PAULA
PRIMARY EXAMINER